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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,199	12/15/2000	Daniel C. Castle	10002991-1	1135
<div>7590 04/30/2007 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400</div>			<div>EXAMINER RETTA, YEHDEGA</div>	
			<div>ART UNIT 3622</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 04/30/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/738,199

Applicant(s)

CASTLE ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 23-30, 32 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21, 23-30, 32 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed February 20, 2007. Applicant amended claims 1, 10, 13, 27, 36 and 37. Claims 1-19, 21, 23-30, 32 and 35-37 are still pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19, 21, 23-30, 32 and 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner would like to point out to applicant, the claimed invention as disclosed in applicant's specification. The specification discloses, advertisers **sending offer price, i.e. the offer, with, and as part of, the actual advertisement submitted to publisher for publication.** In its simplest embodiment, the method simply comprises placing the highest paying ads in the publication, if they will fit, in the descending order corresponding to the offer price (page 4&5). In step 116, advertisements in the ad poll, which comport with subscriber demographic data in SDF, and content that matches the demographic data determine the amount of space available for advertising. As a first step in selecting ads, **those ads in the pool 102, 104, 106 and 108, which will fit with available space are selected, identified or marked as candidates for publication**

in step 116 because they will fit within available advertising space. **Alternatively, an advertiser might specify the size of a placed ad** or, where the ad appears in the publication (see page 5). **After the candidate ads are identified in step 116, in step 118, the advertiser's offered price are compared and stored** and in step 120, **the candidate advertisement that was offered by its advertiser at the highest price is selected** (page 6). In step 122, the heuristic data is read to determine if any of the candidate advertisement have already been sent to the subscriber, in part to determine *if another delivery of* the same, related or similar advertisement is appropriate, and if it is considered that the user has not seen the ad, the ad is placed in the publication and if it is determined that the user have seen the ad, a review of advertiser's ad placement criteria is made (page 7). The specification does not teach determining *if the candidate advertisements* have already been sent to the subscriber *and if additional deliveries of the same*, related or *similar advertisements is appropriate*. The specification instead teaches determining if any of the of the candidate advertisements is has already been sent and determining if another delivery of the same, related or similar advertising is appropriate which indicates that the system determines if an ad (one advertisement) is sent or seen by the subscriber and sending the ad itself or another ad. On page 6, the specification discloses that the sizing of ads and content can, for example, be part of either step 126 or 116 or re-sizing ads and content might be done at any conveniently located step. However nowhere in the specification does it include or disclose that *auctioning the newly resized candidate advertisement to advertisers and auctioning the dynamic content to content providers by receiving at least firs and second offer*. According to applicant disclosure, the advertiser offers the price or is willing to pay the price based on the location of the ad in the publication or the published size of the ads (page 4). On page 5, it discloses that selecting ads

from the pool of ads which will fit within space are selected as candidate for publication or alternatively an advertiser might specify the size of a placed ad or where the ad appears in the publication. Applicant's disclosure does not teach the ad is auctioned after it has being resized nor does it teach that the dynamic content is auctioned to content providers. Applicant also does disclose the candidate advertisements represented by advertisers that are in good credit standing.

Independent claims 10, 13, 27 and 36 recite, the same limitation therefore, the above stated rejection applies.

Claims 1-19, 21, 23-30, 32 and 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose *identifying subscriber where candidate advertisements are to be sent according to subscriber's demographic data; then automatically resizing the candidate advertisements to fit with available advertising location on the page in online publication and auctioning the newly resized candidate advertisements to advertisers and auctioning the dynamic content to content providers.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "automatically resizing the candidate advertisements to fit with available advertising location on the page". The claim also recites, "placing on the page of said on-line publication" on page 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, 13-19, 21, 24-30, 32 and 35-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (US 5,974,398) in view of Markowitz et al. (US 6,311,185).

Regarding claims 1, 4, 6-9, 11, 13-19, 21, 24-30, 32 and 35, Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; offers as bids or auction-type (see col. 5 lines 3-12); identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); selecting content information based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23); determining if any of the advertisement have already been sent or viewed by the subscriber (see col. 5 lines 10-22); Markowitz teaches identifying at least one subscriber for placing advertisement; using of heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); determine all available

advertisement locations and placing ads on all the available locations and resizing the content to fit within the available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to resize the ads of Hanson as in Markowitz in order to properly lay the advertisement in the publication without obscuring any information, as taught in Markowitz.

Regarding claims 2-3 and 5, both Markowitz and Hanson teaches publication distributed for publication using the Internet, wherein the publication is comprised of information obtained from a plurality of sources (see Markowitz col. 2 lines 19-36, col. 3 lines 1-50 and Hanson col. 9 line 62 to col. 10 line 6, col. 11 line 57 to col. 12 line 27).

Regarding claim 36, Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); selecting content information based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23). Markowitz teaches a computer identifying advertisement that comport with the subscriber profile; data storage where the profile information is stored; an interface enabling the exchange of data between advertisers and first computer and between subscribers to said publication and first computer (see fig. 1-4, abstract, col. 2 lines 19-35) using of heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); determining all available advertisement locations and placing the ads on all the available locations and resizing the content and to fit within the

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available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to resize the ads of Hanson as in Markowitz in order to properly lay the advertisement in the publication without obscuring any information, as taught in Markowitz.

Claim 37 is rejected as stated above in claim 1.

Claims 10 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz et al. (US 6,311,185) in view of Hanson et al. (US 5,974,398).

Regarding claims 10 and 12, Markowitz teaches receiving a publication into which advertising material as an advertisement to be placed for publication using a predetermined methodology (see fig. 3, abstract, col. 2 lines 19-36, col. 3 line 65 to col. 3 line 18); using heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); placing the ads on all the available locations and resizing the content and to fit within the available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45); automatically resizing the advertisement corresponding to an advertiser to fit within a publication space on the page and automatically resizing at least one of the existing content to fit within available space on the page (see col. 3 line 19 to col. 4 line 15). Markowitz teaches wherein the steps are performed an Internet service provider (see 2 lines 50-67). Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); selecting

content information based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23). It would have been obvious to one of ordinary skill in the art at the time of the invention to select the ads of Markowitz based on the highest price, as in Hanson, to maximize the revenue of the service provider.

Response to Arguments

Applicant's arguments filed February 22, 2007 have been fully considered but they are not persuasive. Regarding the rejection of 102 and 103, applicant argues that Markowitz does not teach automatically resizing the candidate advertisement and then auctioning the resized candidate advertisements and the resized dynamic content. Markowitz teaches automatically resizing the advertisement to fit a web page. Markowitz discloses the advertisement can be positioned to stand out from the original web page without obscuring any information, and the size and color of the advertisement can be adjusted to this end, moreover the server could modify the HTML of the original web page to move and/or shrink the text and graphic regions (see col. 3 lines 29-37). Regarding the auctioning of the resized advertisement, Examiner would like to point out that applicant also does not teach this feature. Hanson teaches obtaining offers from advertisers to place ads on web pages (see abstract, col. 5 lines 3-21).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTA YEHDEGA
PRIMARY EXAMINER